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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,381	10/28/2003	Albert K. Chin	06-00741US05	8269
87836 7590 01/28/2010 Vista IP Law Group, LLP (Maquet) 1885 Lundy Avenue Suite 108 San Jose, CA 95131				
EXAMINER SMITH, PHILIP ROBERT				
ART UNIT		PAPER NUMBER		
3739				
MAIL DATE		DELIVERY MODE		
01/28/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/696,381

Applicant(s)

CHIN, ALBERT K.

Examiner

PHILIP R. SMITH

Art Unit

3739

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 January 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Linda C Dvorak/
Supervisory Patent Examiner, Art Unit 3739

/Philip R Smith/
Examiner, Art Unit 3739

Continuation of 11, does NOT place the application in condition for allowance because:

In Section I, Applicant contends that claims 27-35 satisfy §112, first paragraph, because Figures 5 and 6 support "[an] outer sheath having a distal tip for dissecting tissue." However, the invention of Figure 5-6 is an "alternate embodiment" of the invention which is mutually exclusive with the invention to which previous claims have been directed. Therefore, if claims 27-35 are supported by Figures 5 and 6, then they are directed toward a distinct embodiment of the invention, and should accordingly be withdrawn.

In Section II, Applicant contends that "[t]here is nothing in Horzewski that discloses or suggests that the bulbous region is configured to dissect tissue, as described in claim 15." But it is maintained that element "127" is capable of dissecting tissue, and that it is not necessary for Horzewski to point out the inherent capabilities of the disclosed elements. As noted in 12/64-68, element "127" has a "leading taper 123" that is out in front of the sheath. This arrangement of elements is certainly enables the "bulbous tip 127" to dissect tissue.

Applicant further contends in Section II that "to the extent that the bulbous region 127 is analogized as the claimed distal tip, making the bulbous region 127 transparent would not enable any more viewing than what the device can already accomplish." On the contrary, replacing the presumably opaque material for constructing element "127" with a transparent material would surely enable "more viewing." If any portion of Horzewski's dilator which previously blocked light was constructed with transparent material, the dilator would enable that much more viewing. In any event, it is obvious to combine known elements that yield predictable results. KSR v. Teleflex. There is no result of making "127" transparent that would not be predicted by a skilled artisan.

Applicant further contends in Section II that "Horzewski teaches a device with a through lumen so that a guidewire can extend therethrough ...[p]lacing the tip of Chin on Horzewski's device would prevent the guidewire from extending though the sheath." This is a persuasive characterization of Horzewski. However, it is not clear that preventing the guidewire from extending though the sheath would render Horzewski's dilator "inoperable." It would only make eliminate the option of utilizing Horzewski's dilator in tandem with a guidewire. During an angioplasty, a guidewire is necessary, and Horzewski is primarily concerned with angioplasty. Therefore, his device accommodates a guidewire. However, as noted in 6/7-17: "For brevity, we have focused this discussion on the application of our invention to the construction of medical instrument delivery devices, percutaneous intravascular sheaths and guidewire channels. However, it is understood that the scope of our invention is not limited the these particular applications. The use of a radially-expandable tube in the construction of guiding catheters enables the manufacture of said delivery systems with lower profiles relative to prior art delivery devices of commensurate function and delivery capacity." It is maintained that substituting the tip of Chin for the tip of Horzewski would not make Horzewski's device "inoperable"; it would only make it inoperable for a given subset of utilizations that require a guidewire. Moreover, an alternative basis of an obviousness rejection is available: it would have been obvious to a skilled artisan that the transparent material for tip construction disclosed by Chin be substituted for the presumably opaque material disclosed by Horzewski. In such an instance, the device of Horzewski would still accommodate a guidewire.